

REMARKS

Claims 1-6 were originally filed in this application. In this response, claims 1, 6, and 15 have been amended. New claims 26-36 have been added. Consequently, claims 1-6 remain under consideration. Amendment of a claim is not to be construed as a dedication to the public of any subject matter.

Claim Objections

The Examiner has objected to claims 1 and 15 for several informalities. Applicants would like to thank Examiner for pointing out the claim informalities. Claims 1 and 15 have been amended to correct these informalities.

Claim Rejections - 35 U.S.C. § 112

The Examiner has rejected Claims 1-25 under 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 6, and 15 have been amended to correct the antecedent basis of all limitations in these claims.

Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected Claims 1-25 under 35 U.S.C. § 103 as being unpatentable by Baerlocher et al. (U.S. Patent 6,406,369) in view of Vancura (U.S. Patent 6,409,172). However, there is no teaching in either reference of the probability of winning a further prize being related to an initial prize.

To establish *prima facie* obviousness of a claimed invention, three requirements need to be present. First, all the claim limitations must be taught or suggested by the prior art. *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1337 (Fed. Cir. 2003), See also MPRP 2143.03. Second, there must be some suggestion or motivation to combine the teachings, either in the references or in the ordinary skill. Third, an expectation of success must be present.

Referring particularly to column 8, lines 25-40, Baerlocher discloses a multi-stage bonus scheme, where the player progresses through the stages of the bonus to win progressively higher awards. The probability of success of advancing to the next stage decreases for each stage. The specification also discloses that if there is a linear increase in the prizes, then there should be a linear increase in the prizes, then there should be a linear decrease in the probability of progressing to each subsequent stage and if there is a non-linear increase in prize value, then the probability should also change in a non-linear way.

The Applicants respectfully agree with the Examiner's conclusion that Baerlocher does not explicitly disclose determining the probability of the player successfully winning a further prize using the value of an initial prize. However, the Applicant disagrees that the invention claimed in any of the claims 1-25 is obvious in light of this disclosure.

Referring to page 4, lines 4-10 of the office action, the Examiner asserts that use of the value of the initial prize to determine the probability of the player successfully winning a further prize is obviously disclosed. The Applicants assert that on a proper reading of Baerlocher this conclusion can not be supported. The Applicants acknowledge that Baerlocher discloses that the probability of advancement from one position to the next decreases in accordance with the increase of the multipliers and that the value of the prize is determining by multiplying the player's bet by the bonus multiplier achieved. However, the Applicants submit that this only discloses relating the probability of achieving a particular position in the game to the size of the prize that will be won if that position is achieved. Accordingly, the higher the potential prize, the less the probability of achieving that prize, irrespective of what has been won previously. The probability of achieving each prize is therefore independent of the value of the initial prize.

This independence is made clear when it is considered that the prizes are multipliers of previously awarded prizes, but no matter what the value of the previously awarded prize, the probability of progressing through the stages remains constant. Accordingly, the probability of progressing in the bonus described by Baerlocher is independent of the value of the initial prize. Referring to the linear example taught by Baerlocher, if the first stage has a 50X multiplier prize

and the second stage has a 100X multiplier prize, then for a bet of 1 credit the prize awarded if the bonus ends on the first stage is 50 credits, but for a bet of 10 credits, the prize awarded if bonus ends on the first stage is 500 credits. However, regardless of whether the player has bet 1 credit or 10 credits, Baerlocher teaches that the probability of progressing to the second stage remains constant at 90%. Accordingly, Baerlocher teaches away from the pending claims as claimed by the Applicant.

Vancura describes a game having a plurality of paths, with each path to provide the same return to player, despite having different prizes along the path. The game is played like a board game, with the player landing on one or more positions along a path (see for example, column 3, lines 22-37). In addition, a single path may split into two paths at a decision point (see for example, column 6, line 29-44). Vancura states this arrangement allows the player to have control over the volatility of the game without affecting the overall return to player of the bonus award.

The Examiner states that Vancura “discloses relating a probability of landing on each position to the prize value of each position so that a pre-determined game return is maintained in the casino” and that this disclosure in combination with the disclosure of Baerlocher renders the Applicants’ invention as claimed in claim 1 obvious. Even if Vancura discloses the probability of landing on a square along a path is related to the prize value of the square and the return to the player of the path is fixed at a certain level, this does not disclose using the value of a previously awarded prize to determine the probability of achieving a subsequent prize. This is readily apparent when it is considered that in the game disclosed by Vancura, it is not necessary to progress through each and every square on a path, (see for example, Column 3, lines 22-29 where the marker transverses from “Start” to “Win 60” without stopping on the “Win 50” square). Therefore, the prize won from the square proceeding the current square is variable, yet Vancura reaches that the probability of landing on all of the squares remains constant.

Therefore, in view of above, it is not obvious for those skilled in the art to obtain the gaming machine of the present claims based on the teachings of Baerlocher et al in view of

Vancura. Thus the Applicants respectfully request that the Examiner withdraw the 35 U.S.C. 103 (a) rejections to claims 1-25.

With particular reference to claim 8, this claim specifies that in each subsequent step of the game the player is able to switch from one pathway to another pathway. This is in contrast to the bonus game disclosed by Vancura, in which the player can only choose which of the plurality of pathways to take when the player is at a decision node. Referring to column 8, lines 11-14, Vancura discloses that the decision nodes are only particular points along a pathway and are not provided at *each* step along the pathway. In addition, referring to column 8, lines 11-17, Vancura explicitly discloses that the player is *choosing* a path, rather than *switching* from one pathway to another pathway. In addition, referring to Figure 1 of Vancura, it is apparent that once the player makes the initial choice to take the lower or upper pathway, there is no option to switch to the other pathway and no option to make a switch at each step of the game.

New claim 26 contains the features from claim 1 of the probability of winning a further prize being related to an initial prize and is therefore patentable for the reasons set out above. In addition, claim 26 requires that the player wager at least a portion of an initial prize of the player wants to purchase the chance to win the further prize and that the player has at least some control over the value of either the wager or the further prize and that the probability of winning the further prize is related to the value of the further prize. Neither of the cited documents cited teach that the probability of winning is related to both the size of the wager, which is at least a portion of an initial prize and the value of the further prize that may be won by staking the wager.

Referring to new claim 33, neither of the cited documents cited disclose determining whether a further prize is won based on the wager divided by the sum of the wager and the further prize. The documents cited do not disclose a wager being made and not disclose the probability of winning being related to the wager in this way. Therefore, claim 33 is patentable over the cited prior art for at least this reason.

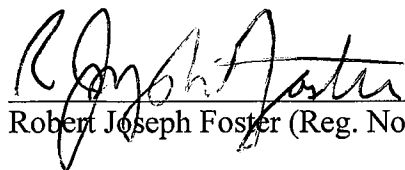
Referring to new claim 34, neither of the cited documents disclose a prize awarding process in which a plurality of prizes are associated with each stage and the player is able to choose which one of the prizes are associated with each stage and the player is able to choose which one of the prizes will be awarded if the prize awarding process ends at that stage, with the probability of the prize winning process ending on a stage being a function of each of the prizes that have been selected by the player for that stage. As discussed previously, the documents do not disclose relating the values of prizes already won to the probability of the process ending on a stage.

Conclusion

Applicants have complied with all requirements in the above-referenced communication. Applicants submit that the present application is in condition for allowance and therefore respectfully request that a timely Notice of Allowance be issued in this case. Should matters remain, which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicants' undersigned agent.

The Director is authorized to charge any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to Deposit Account Number **50-2638**. Please ensure that Attorney Docket Number 75144-011600 is referred to when charging any payments or credits for this case.

Respectfully submitted,



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